

## I. Introduction

Claims 1-20 have been cancelled without prejudice by this amendment, the Applicant reserving the right to timely file a continuation application for the protection of the invention defined by the cancelled claims. Accordingly, only claims 21-24 are currently pending and submitted herein for review and reconsideration by the Examiner.

## II. 35 U.S.C. §112 Rejection

Claims 21-24 were rejected as being indefinite for the reasons set forth in Para. 5 of the Outstanding Office Action. Specifically, the Examiner indicated that the recitation of the phrase "said interior bore" lacks antecedent basis. Although the Examiner referred to line 12 of claim 24 as the location of such recitation, Applicant believes that the Examiner intended to refer to claim 21. Accordingly, line 12 of claim 21 has been amended by replacing "interior" with "axial" (for which there is antecedent basis in line 3). Accordingly, this ground of rejection has been rendered moot and should be withdrawn by the Examiner.

Although it was not noted by the Examiner as a source of indefiniteness, Applicant, for the purposes of accuracy and clarity, has further amended claim 21 by replacing the phrase "a lower edge" with --an end region--. The necessity for this amendment is believed to be readily ascertainable by reference to FIG. 1 and lines 11-12 of claim 21, wherein it will be appreciated that the lower edge of the annular sidewall is insertable into the tubular member 14 and frictionally receivable therein (as claimed) and that the external annular ring is disposed proximate the opposite end of the sidewall portion, and therefore not proximate "a lower edge" thereof. As such, it is believed that no new issues are raised by this amendment and that no new search or further consideration is necessitated thereby.

III. 35 U.S.C. §102(b) Rejection

Claims 21-24 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,409,854 to Solazzi (hereinafter "Solazzi '854"). This rejection is respectfully traversed. The discussion which follows will be with respect to Claim 21, the only independent claim currently pending in this application, with the understanding that if Claim 21 is allowable, then all claims depending therefrom are also allowable.

The present invention, as set forth in Claim 21, is directed to a sample container which includes a tubular member defining an axial bore and a receptacle member having a tubular sidewall portion axially alignable with and frictional receivable within the axial bore of the tubular member. Claim 21 further recites that the receptacle member includes an exterior annular collar disposed proximate an edge of the tubular sidewall portion.

As indicated above, Claim 21 was rejected as being anticipated by Solazzi '854. In an anticipating reference, all the claimed elements must be found in exactly the same situation and united in the same way to perform the identical function. Ceramic Tilers Supply, Inc. v. Tile Council of America, 378 F.2d 283, 284-285 (9th Cir. 1967). Accordingly, the Solazzi '854 reference does not meet the requirements of 35 U.S.C. §102(b) if it does not teach or disclose each and every element recited in the claims.

In Para. 7 of the outstanding Office Action, the Examiner accurately determined that Fig. 2 of Solazzi '854 shows a tubular member (18) and a receptacle member (17) having a tubular sidewall portion axially alignable with the tubular member and frictionally receivable within the axial bore thereof. As indicated above, in the interest of accuracy, the recitation of "lower edge" in claim 21 has been replaced with "an end region". Insofar as the annular collar (19) identified by the Examiner as being disposed "proximate a lower edge of the tubular sidewall portion" may also be more accurately characterized as being disposed as proximate an end region of the sidewall portion (see FIG. 3), Applicant submits that despite the inaccuracy, the meaning of the "lower edge" as intended by Applicant, was indeed understood by the Examiner. Accordingly, it is

abundantly clear that amending the language of claim 21 to be consistent with the Examiner's interpretation does not involve the raising of any new issues or require any additional consideration or search.

Claim 21 positively and unambiguously recites that the tubular member and receptacle member are arrangeable to form a sample receptacle by placing a flexible sheet on the upper edge of the tubular sidewall portion and inserting the same into the axial bore of the tubular member until a surface of the annular collar engages a circumferential edge of the tubular member. To ensure that the recitation of this arrangement is accorded patentable weight by the Examiner, Applicant has replaced the functional term "whereby" with the term "wherein".

A description of how the tubular member, receptacle member, and annular collar of Solazzi '854 interrelate to form a sample container is described in Col. 3, line 47 et seq., wherein it is set forth that:

A thin plastic film is placed over the opening 34 [of the receptacle member] with the side edges of the film directed about the sides of the cell. The snap on ring 19 is then placed over the aperture in the cell... and is pushed down until it locks in position by abutting against the edge 44 of the cell 17. The interior ridge of the ring 19 in conjunction with the tapered neck 30 of the cell 17 firmly grasps the film 40 during assembly to maintain a taut, wrinkle free sample plane (emphasis added).

In FIG. 3 of Solazzi '854, it can be seen that when the tubular member 18 is thereafter inserted over the opening 34 in the manner described, the annular collar of the receptacle member does not contact the circumferential edge of the tubular member. The Examiner can not have it both ways. If he construes the movable annular collar of Solazzi '854 to be disposed proximate an end region of the sidewall portion for the purposes of the one claim limitation, he can not then assert that that same collar contacts the edge of the tubular member. Such a construction is wholly inconsistent with the teachings of the Solazzi '854 reference, as clearly shown in FIG. 3.

Accordingly, it is respectfully submitted that the Solazzi '854 reference does not include a receptacle member having an annular collar proximate an tubular sidewall end portion thereof and arranged such that when the tubular sidewall is inserted into a tubular member, the edge of the tubular member contacts the annular collar. As such, Solazzi '854 does not anticipate each and every element of the claimed invention as defined in Claim 21, and this rejection, upon reconsideration thereof, should be withdrawn by the Examiner.

Accordingly, applicants submit that Claims 21-24, as amended, as well as all claims depending therefrom, are presently in condition for allowance, early notice of which is respectfully solicited.

#### IV. Summary

The prior art of record simply does not anticipate, disclose, or suggest the features of the present invention as presently claimed. The Examiner's 35 U.S.C. §102(b) rejection is therefore believed to be overcome. Having fully distinguished the present invention from the cited prior art, it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance, early notice of which is earnestly solicited. However, if the Examiner is of the opinion that such action can not be taken, the Examiner is invited to call the applicant's attorney at (908) 572-5858 in order that any outstanding issues may be resolved without the necessity of issuing a further Office Action.

V. Fees

No fees are believed to be due as a result of this amendment. If there are any additional fees due and owing, please charge our Deposit Account No. 16-2131.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
SOLAZZI

Serial No.: 08/010,555

Filed: January 28, 1993

For: METHOD AND APPARATUS FOR  
TRIMLESS SAMPLE CUP USED IN  
X-RAY SPECTROSCOPY

Honorable Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Group Art Unit: 1809

Examiner: M. Cano

Dated: October 28, 1993

Docket No.: CHEMPLEX-3

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GROUP 1809

Sir:

Transmitted herewith is an amendment in the above-identified application. The fee has been calculated as shown below.

(1) CLAIMS AFTER AMENDMENT	(2) CLAIMS PREVIOUSLY PAID FOR	(3) PRESENT EXTRA	SMALL ENTITY RATE	or	LARGE ENTITY RATE	or	LARGE ENTITY RATE
Total Claims* <u>4</u>	-** <u>24</u>	<u>0</u>	x \$ 11=	\$ 0	\$ 22=	\$ 0	
Indep. Claims* <u>1</u>	-*** <u>3</u>	<u>0</u>	x \$ 37=	\$ 0	\$ 74=	\$ 0	
Fee for First Presentation of Multiple Dependent Claim(s)			\$115=	<u>\$0</u>	\$230=	<u>\$ 0</u>	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT				\$ 0	or	\$ 0	

\* If the entry in Col. (1) is less than the entry in Col. (2) write "0" in Col. (3).

\*\* If the "Claims Previously Paid For" in this space is less than 20, write "20" in this space.

\*\*\* If the "Claims Previously Paid For" in this space is less than 3, write "3" in this space.

1.  No additional fee is required.
2.  Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted, or enclosed herewith.
3.  A check in the amount of \$ \_\_\_\_\_ is attached.
4.  Charge \$ \_\_\_\_\_ to Deposit Account No. 16-2131. A duplicate copy of this sheet is enclosed.
5.  Please charge any additional fees or credit overpayment to Deposit Account No. 16-2131. A duplicate copy of this sheet is enclosed.
6.  A \_\_\_\_\_ month extension of time is requested and a check in the amount of \$ \_\_\_\_\_ is enclosed.
7.  Please charge any extension fees to Deposit Account No. 16-2131. Checking this box authorizes a deduction from our deposit account to cover any extension fees which may be due.

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